

REMARKS

N.B. Applicant respectfully requests the Examiner to acknowledge both the claim for priority and receipt of the certified priority document filed on May 5, 2004.

As requested by the Examiner, Applicant cancels the non-elected claims 8-14 but expressly reserves the right to file a Divisional Application to prosecute these claims.

Applicant requests the Examiner to withdraw the objection to claim 17 in view of the above amendment which makes the grammatical correction suggested by the Examiner.

Applicant also respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, in view of the above corrective amendment to claim 15, and further in view of the fact that the Examiner apparently has properly interpreted the claim language which, thus, would not appear to need any further clarification; however, if the Examiner is still unsure of the intended meaning of the language in claims 15-21, she is respectfully requested to **call the undersigned attorney** to discuss the matter.

Applicant respectfully **traverses** the rejection of claims 15-21 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Vijuk '195 in view of Brown '220 and Vijuk '931.

A primary basis for this traversal is that, Applicant respectfully submits, Examiner Musser must have impermissibly relied on the hindsight knowledge of Applicant's own disclosure in an attempt to find obviousness in the subject matter of each of claims 15-21.

Applicant incorporates herein by reference Applicant's still valid remarks in the Amendment filed June 26, 2006, but respectfully requests the Examiner carefully to consider the following **additional** rebuttal arguments.

AMENDMENT AND REQUEST FOR RECONSIDERATION...
U.S. APPLN. NO. 10/702,083

With respect to Applicant's assertion of improper reconstruction of the disclosures of the three cited references, Applicant is particularly concerned with the Examiner's two following conclusory statements of obviousness with respect to claims 15 and 16, respectively:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply hot melt adhesive to regions of the web of Vijuk '195 prior to cutting it and then activate then after folding the web since Brown shows this is an obvious alternative to applying the adhesive after cutting and folding as taught by Brown (Col. 3, ll, 17-68) and since Vijuk '931 shows it is known to use hot melt adhesive with outserts like those of Vijuk '195.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to fold the double width carrier longitudinally so that the edges meet in the center to make a double layered web since Vijuk '931 discloses the carriers can be folded in two directions to make a double layered web and since this would allow formation of two adjacent double layered carriers and to perform this folding while the web is continuous since longitudinally folding a continuous web is simple.

The Examiner views Vijuk '195 as disclosing the basic idea of manufacturing a plurality of folded printing carriers or coupons lying adjacent to one another. The Examiner also views the use of "hotmelt" glue as being rendered obvious by Vijuk '931. Applicant respectfully **disagrees** with these views.

1. Vijuk '915 relates to the manufacture of folded coupons, or "outserts" 12. These are severed from a continuous web. Vijuk accomplishes this in that a blank 11 corresponding to the width of the web 28 is severed and transported through a folding station 33. In this folding station the blank is folded with a plurality of folds to assume a position as shown in Fig. 1 of the Vijuk patent in the region of the conveyor 19. The intermediate folding position of the blank is

shown in Fig. 3 and characterized in that a folding tab 14 at the end or edge of the blank remains unfolded. The blank in this configuration (Fig. 3) is then conveyed to a gluing station 40. The top side of the folded layers of the blank (reference number 16 in Fig. 3) is provided with glue spots. Afterwards, a further folding step is executed to fold the leg or tab 14 against the top side of the folded layer 16 and connected thereto by the glue spot 15.

Due to the width of the web and the width of the blank 11 severed from it, the blank is designed for the production of three folded coupons lying next to one another. After the coupons have been finished when the tab 14 is fixed in place, the folded blank is severed at two positions, thus resulting in three folded coupons lying adjacent to one another.

In comparison to Applicant's claimed process, the Vijuk '195 manufacturing process is complicated and disadvantageous. The folding process must necessarily be divided into two independent processes in order to make the glue connection prior to the final folding step. This means that the first, important folding process in the region of the folding station 33 is not fixed or stabilized during subsequent transport and gluing. After leaving the folding station 33, the multiply-folded blank 11 is transported without guiding means and without being fixed in place. Due to the restoring forces exerted by the material in the blank, namely in the folding lines, it can be safely assumed that the fold cannot be correctly held in place until it reaches the second folding station after the gluing station. Particularly in the case of high-speed conveying operations, one must assume that the blank will become partially unfolded by the time it reaches the gluing station. The Vijuk process is thus ineffective and, in terms of the quality of the generated folded coupons, quite inadequate.

2. Applicant respectfully submits that Vijuk '931 has also been interpreted/reconstructed by the Examiner by relying on hindsight gained from the knowledge of Applicant's own disclosure. It should first be kept in mind that the leaflet according to Vijuk '931 has a complex construction, namely that it is folded longitudinally and crosswise (Fig. 8, Fig. 9). As can be seen in the intermediate folded position according to Fig. 8, a glue spot 14a is applied prior to the final folding step in order to connect the outer folding layers of the blank to one another.

With respect to the position of a gluing assembly, Vijuk '931, in column 4, starting at line 3, provides for positioning a *"a gluing station 45 at the folding station"*, specifically in the preferred embodiment *immediately prior to the second folding station 35*. As can be seen from the schematic illustration of the apparatus in Fig. 1, a first folding station for executing folding steps, having the reference number 27 in Fig. 3 – Fig. 7, is positioned at a distance from a second *folding station 35*. After leaving the first folding station, the already folded blank is conveyed to the gluing station 45, provided there with a glue spot at the position shown in Fig. 8, and then folded again.

At the end of the description (column 7, first line), the glue is also specified as being "hotmelt". But, from the overall context, it is obvious that this detail has not been properly considered, as this type of glue hardens shortly after it has been applied to a carrier and must be reactivated through the application of heat and pressure in order to create the connection. However, Vijuk fails to make any reference on this point. Instead, the person of ordinary skill in the art would understand that Vijuk makes no clear recommendation concerning the type of glue

to be employed. The process and the apparatus according to the described and illustrated embodiment are intended for the use of cold glue.

3. In Applicant's claimed invention, hot melt is more than just recommended as a possible type of glue to be used. Instead, the entire production process for the folded coupons is designed to be compatible with the special characteristics of hotmelt glue. This is expressed in the fact that the glue is applied to the continuous material web, specifically at positions which ensure a sustainable connection of the folded coupon. Since the hotmelt glue hardens shortly after its application, the web with the applied glue spots can be conveyed first to a severing assembly for separating the blanks, and then to a folding assembly. The entire, complex folding process is thus executed on the blank with the applied glue spots, but with the hardened, very thinly applied glue posing no interference with the folding process. Immediately following the folding process, pressure and heat are applied to the folded coupon. This stabilizes the folded layers, for one, because the folding lines or folded edges are made more distinct by the application of pressure. And secondly, this also reactivates the glue spots, thus providing an effective connection of the outer legs or layers of the folded coupon.

In summary, the process according to the claimed invention makes it possible to achieve high-performance production levels since the continually conveyed material web is provided with glue as it moves. The choice of hotmelt glue ensures that all subsequent operations, including the complex folding steps, can be executed without interference from the glued areas. Such a process is not taught or suggested by the cited references individually or in combination. Applicant has above explained the deficiencies in the primary reference, Vijuk '195, and it is

AMENDMENT AND REQUEST FOR RECONSIDERATION...
U.S. APPLN. NO. 10/702,083

clear that the disclosures of Brown and Vijuk '931 do not make up for the deficiencies in Vijuk '195. Applicant analyzed the deficiencies in Brown '220 in paragraph 1 bridging pages 10 and 11 of Applicant's previous Amendment. Thus, it is clear that the combination of the disclosures of Brown and the two Vijuk references would not have rendered obvious the subject matter of each of claims 15-21, even if, for some unknown reason, a person would attempt to combine their disclosures as proposed by the Examiner. Furthermore, even if the disclosures of the three references were combined as proposed by the Examiner, there would not be produced the subject matter of any one of the claims 15-21.

In summary, then, Applicant respectfully requests the Examiner to reconsider and withdraw the claim objections, the rejection under 35 U.S.C. § 112, second paragraph, and the rejection under 35 U.S.C. § 103(a), and to find the application to be in condition for allowance with all of claims 15-21; however, if for any reason the Examiner feels that the application is not now in condition for allowance, she is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of One Month. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be

AMENDMENT AND REQUEST FOR RECONSIDERATION...
U.S. APPLN. NO. 10/702,083

charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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